

Docket No.: 114232.0109  
Customer No. 21269

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of

L. SHAPIRO

Serial No.: 09/518,076

Filed: March 3, 2000

Group Art Unit: 1653

Examiner: Mohamed, A.

For: INHIBITORS OF SERINE PROTEASE ACTIVITY, METHODS AND  
COMPOSITIONS FOR TREATMENT OF HERPES VIRUSES

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**RESPONSE TO RESTRICTION REQUIREMENT**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

In response to the Office Action mailed July 3, 2001, Paper No. 7, Applicant respectfully requests reconsideration of this application in view of the following remarks.

**REMARKS**

Claims 1-39 are presently pending in the application. Reconsideration and allowance of all claims are respectfully requested in view of the following remarks.

**Response to Restriction Requirement**

In the Office Acton mailed July 3, 2001, the Examiner has required restriction under 35 U.S.C. § 121 between Groups I, II, III, IV, V, VI, VII, VIII, IX, X, XI, XII, and XIII. In addition, the Examiner also stated that if Group I is elected, Applicant must further elect between species I, II, III, IV or V; if Group VII is elected, Applicant must elect a single substance recited in claim 22; and if Group X is elected, Applicant must elect a single substance recited in claim 30.

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Applicant respectfully traverses both the restriction and election requirements. However, to be fully responsive, Applicant provisionally elects, with traverse, the claims of Group I (i.e. claims 1-15), and Species V (i.e. the substances recited in claim 15).

Applicants note that the Office Action is ambiguous. On page 8 of the Office Action, the Examiner states that Applicant is required to elect a single species (i.e. a single disease, or virus, or substance, or peptide). Applicant believes this remark is relevant only to the Group VII or Group X election requirement as the Examiner has explicitly identified the choice to be made in Group I-- i.e., Species I, Species II, Species III, Species IV, or Species V. Applicant believes therefore that they have been fully responsive to the restriction/election requirement by elected Group I and Species V.

A requirement for restriction/election is proper when 1) the inventions as claimed are distinct and 2) a serious burden is placed on the examiner if restriction is not required. M.P.E.P. § 803. The restriction requirement is traversed because a search and examination of all the claims would not impose a serious burden upon the Examiner. The Examiner must provide reasons and/or examples to support conclusions. *Id.* The Examiner has not shown that it would be a serious burden to prosecute all of the claims (and all of the species) of the application.

More specifically, with respect to the restriction requirement, the Examiner states that "these inventions . . . have acquired a separate status in the art as shown by their different classification and because [therefore] the searches for the individual groups are not coextensive, restriction for examination purposes as indicated is proper." This statement is not supported by facts as presented in the Office Action. The classes and subclasses of Groups II-XIII are entirely encompassed by the classes and subclasses identified in Group I. Thus a search on Group I would be coextensive with

Docket No.: 114232.0109

Customer No. 21269

PATENT

a search on all other groups, requiring searching the art areas identified as appropriate to the other groups. With respect to the election requirement, the Examiner has not provided any reasons why the examination of all the claims and even all the species would be a serious burden.

### **CONCLUSION**

In view of the foregoing remarks, Applicant respectfully requests withdrawal of the restriction and election requirements and the examination of all of the pending claims and species together.

### **AUTHORIZATION**

As this response is filed within the shortened statutory period, no fee for extension is of time is believed to be due. The Commissioner, however, is hereby authorized to charge any fees necessary for consideration of this response, including any extension-of-time fees, or credit any overpayment, to Deposit Account No. 50-0436.

Respectfully submitted,

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**CERTIFICATE OF FACSIMILE TRANSMISSION**

Assistant Commissioner for Patents  
Washington, D. C. 20231

Sir:

The undersigned hereby certifies that a Response to the Office Action, mailed July 3, 2001, Paper No. 7, is being facsimile transmitted to the Patent and Trademark Office to Examiner Abdel A. Mohamed (Fax No. (703) 308-4242) on August 2, 2001. This facsimile transmission includes a total of 4 pages (1 page of Certificate of Facsimile Transmission and 3 pages of Response).

Respectfully submitted,

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